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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/715,317 | 11/17/2003 | Michael T. Stanhope | 011920-1401 | 5107 |

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| EXAMINER | |
|---|---|
| SPERTY, ARDEN B | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1771 | |

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/715,317 | STANHOPE ET AL. | |
| | Examiner | Art Unit | |
| | Arden B. Sperty | 1771 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *Application filed 11/17/03*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *25 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/17/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-24, drawn to a flame resistant fabric, classified in class 442, subclass 301.

   II. Claims 25-26, drawn to a method of making a flame resistant fabric, classified in class 28, subclass 100.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process such as one employing filament yarns to form the body of the fabric.

3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with David Risley on August 15, 2005 a provisional election was made with traverse to prosecute the invention of a flame resistant fabric, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 8, 13-17, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6624096 to Thomas et al.

8. The Thomas reference teaches a flame resistant textile comprising a body of spun yarns of the type listed in claims 2 and 14 (col. 2, lines 22-33), and filament yarns woven in discrete positions. The filament yarns are aramid filaments, thus reading on claim 1 wherein a polyamide filament is recited. Thus, the limitations of claims 1-3, and 15 are met. The filament yarns are single yarns made of multiple filaments, therefore the limitations of both claims 4 and 5 (and 16-17) are met. Regarding claims 8 and 20, the filament yarns have a denier of 200 to 1500 denier (col. 2, lines 59-60).

9. Claims 1-4, 8-16, and 20-24, are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3729920 to Sayers et al.

10. The Sayers reference teaches flame resistant yarns and woven fabrics made therefrom (col. 1, lines 1-8). The yarn, which is analogous to the claimed tough yarn, comprises a glass filament core (col. 2, lines 21-24), surrounded by a spun roving sheath made of modacrylic or flame resistant cellulosic materials (col. 1, lines 17-20, 30-47), thus the compositional limitations of the fibers are met. The yarns are intended for use in woven or knit fabrics, therefore the yarns are provided in discrete positions within the body. Example 2 describes an embodiment wherein two non-identical yarns are used in the making of a fabric product, although a woven product comprising only one type of the flame resistant yarns (such as that of Example 1) would also anticipate the limitations of claim 1, wherein it is required that the body comprises a plurality of flame resistant yarns. Therefore, the limitations of claims 1, 4, 9-13, 16, and 21-24 are met.

11. Regarding claims 2 and 14, the fabric embodiment described in Sayers' Example 2 includes two variations of the Sayers yarn. Therefore, both variations include a spun roving sheath, and the limitations of the claim are met. Incidentally, a fabric comprising only a single variation or embodiment of the Sayers yarn would still anticipate the claim limitations; the claims do not require that the body yarns and the relatively tough yarns must be different.

12. Regarding claims 3 and 15, woven fabrics are grids. In a woven fabric, each yarn is provided in a discrete position. Therefore, a woven fabric made of the disclosed yarn meets the limitations of the claim.

13. Regarding claims 8 and 20, the glass filament core has a denier of approximately 300 (col. 2, lines 48).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 6, 7, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6624096 to Thomas as applied to claim 1 above.

16. The Thomas reference discloses aramid fibers, and is silent with respect to the materials of claims 6, 7, 18 and 19. Despite the lack of explicit teaching of the claimed materials, PBO, HDPE, aramid, and the like, are known functional equivalents in the art, having similar strength, toughness, and resilience characteristics. It has been held to be within the general level of skill of one in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore it would have been obvious to select any of the above materials as desired.

17. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sayer as applied to claim 1 above, and further in view of US Patent 6624096 to Thomas.

18. The Thomas reference teaches alternative fabric weaves, wherein the fabric includes selectively placed flame resistant yarns. The Sayers reference desires a fabric which is flexible and lighter in weight than other examples within the same reference (col. 2 lines 56-60). Therefore, it would have been obvious to one of ordinary skill in the art to form a fabric with the selectively placed flame resistant yarns, as taught by Thomas, motivated by the desire for a lighter weight, more flexible fabric which still possesses the desirable properties of Sayers flame resistant yarns.

***Double Patenting***

19. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-13, and 17-24 of copending Application No. 10/269213. Although the conflicting claims are not identical, they are not patentably distinct from each other because every claim in the present application is suggested by the claims of the conflicting application. The claims may not be stated in the same order as in the conflicting application, but the subject matter and cumulative products are the same

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 15-17, 21-32, 34-38, 40-42, and 45-48 of copending Application No. 10/165795. Although the conflicting claims are not identical, they are not patentably distinct from each other because every claim in the present application is suggested by the claims of the conflicting application. The claims may not be stated in the same order as in the conflicting application, but the subject matter and cumulative products are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arden B. Sperty
Examiner
Art Unit 1771

August 17, 2005

CHERYL A. JUSKA
PRIMARY EXAMINER